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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/996,823

11/30/2001

Kevin Curtis

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05/24/2004

MORRISON & FOERSTER LLP
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EXAMINER

ASSAF, FAYEZ G

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/996,823

Applicant(s)

CURTIS, KEVIN

Examiner

Fayez G. Assaf

Art Unit

2872

-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) 17-34 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/30/2001
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of invention I:
claims: 1-16 in the Response filed 4/2/2004 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs
of 35 U.S.C. 102 that form the basis for the rejections under
this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or
a foreign country or in public use or on sale in this country, more than one
year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 13 are rejected under 35 U.S.C. 102(b) as
being anticipated by Nunzi (EPO 0453362 A1.)

Regarding claims 1, 5 and 13, Nunzi discloses a tunable
optical device (see Fig. 1) comprising one or more filters (12
of Fig. 1), wherein at least one filter comprises one or more
electroactive polymer, one or more photoactive materials (line
15 to line 19 of page 3 of the translated abstract), one or more
grating (13 of Fig. 1).

Regarding claim 2, Nunzi discloses the grating being within
the filter (se Fig. 1.)

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Regarding claim 3, Nunzi discloses the filter being in a shape of a waveguide.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6-12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nunzi.

Regarding claims 11, 12 and 14-16, Nunzi discloses the claimed invention including elastimer and photoactive materials (line 27 of page 1 to line 48 of page 7). However, it not clear if Nunzi discloses the claimed materials.

However, the selection of a known material based on its suitability for its intended use does not serve as basis for patentability.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize any of the claimed materials, since it have been held to be within the

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ordinary skill of worker in the art to select a known material on the basis of its suitability for the intended use. One would have been motivated to use any of the claimed materials, because of its availability.

Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945).

The examiner, lacking showing to the contrary, cannot attribute any particular criticality to the disclosed materials.

Regarding claims 4 and 8, Nunzi discloses the claimed invention except for the filters being stacked together and being independently controlled.

However, such features are well known in optical devices employing fillers.

It would have been obvious, at the time was made, to a person having ordinary skill in the art to stack filters together and control them independently for the purpose of filtering for the purpose of filtering of multiplicity of wavelengths.

Regarding claims 6, 7, 9, and 10, the combination discloses such features as result of the proper choice of materials.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

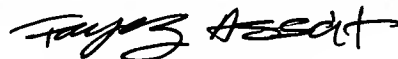
Yamada et al. (US 5,185,829)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fayez G. Assaf whose telephone number is (571) 272-2307. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fayez G. Assaf
Examiner

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5/18/04